



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,717	07/29/2004	Homer E. Aguinaldo	PU2238	4716

  

23454	7590	11/02/2005
-------	------	------------

CALLAWAY GOLF COMPANY  
2180 RUTHERFORD ROAD  
CARLSBAD, CA 92008-7328

EXAMINER	
HUNTER, ALVIN A	

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 11/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/710,717	AGUINALDO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Alvin A. Hunter	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/23/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 3711

### DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-3, 5-10, 12, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Dewanjee et al. (USPN 6887164)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Dewanjee et al. discloses an iron type club head comprising a body including a front wall having a ball-striking surface, and the body further including a rear surface having an external rear cavity formed therein wherein the rear surface includes an upper portion and a lower portion wherein the upper portion is separated from the lower portion by the external rear cavity and at least one groove and the lower portion of the rear surface having a notch formed therein wherein the notch is in communication with the external rear cavity (See Figures 3 and 4).

Regarding claim 2, Dewanjee et al. shows the at least one groove extending from the external rear cavity towards a heel end of the club head (See Figures 3 and 4).

Regarding claim 3, Dewanjee et al. shows the at least one groove including a first groove extending from the external rear cavity toward the heel end of the club head and a second groove extending toward a toe end of the club head (See Figure 3).

Regarding claim 5, Dewanjee et al. shows the lower portion of the rear surface extending further rearward than the upper portion of the rear surface (See Figure 4).

Regarding claim 7, Dewanjee et al. shows an undercut recess along the external cavity for receiving a medallion (See Figures 1-4).

Regarding claim 8, Dewanjee et al. discloses the body made of steel (See Column 3 and 4).

Regarding claim 9, Dewanjee et al. discloses the moment of inertia  $I_{xx}$  through the center of gravity of 2450 to 3200 g-cm<sup>2</sup> and moment of inertia  $I_{zz}$  of 2200 to 3000 g-cm<sup>2</sup> (See Column 7, lines 4 through 16).

Regarding claim 10, see the above regarding claims 1, 3, and 8.

Regarding claim 12, see the above regarding claim 5.

Regarding claim 14, see the above regarding claim 7.

Regarding claim 15, see the above regarding claims 1, 3, 5, 8, and 12.

Claims 1-3, 5-10, 12, 14, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Wieland et al. (USPN 6857973)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art

Art Unit: 3711

under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding claim 1, Wieland et al. discloses an iron type club head comprising a body including a front wall having a ball-striking surface, and the body further including a rear surface having an external rear cavity formed therein wherein the rear surface includes an upper portion and a lower portion wherein the upper portion is separated from the lower portion by the external rear cavity and at least one groove and the lower portion of the rear surface having a notch formed therein wherein the notch is in communication with the external rear cavity (See Figures 3 and 4).

Regarding claim 2, Wieland et al. shows the at least one groove extending from the external rear cavity towards a heel end of the club head (See Figures 3 and 4).

Regarding claim 3, Wieland et al. shows the at least one groove including a first groove extending from the external rear cavity toward the heel end of the club head and a second groove extending toward a toe end of the club head (See Figure 3).

Regarding claim 5, Wieland et al. shows the lower portion of the rear surface extending further rearward than the upper portion of the rear surface (See Figure 4).

Regarding claim 7, Wieland et al. shows an undercut recess along the external cavity for receiving a medallion (See Figures 1-4).

Regarding claim 8, Wieland et al. discloses the body made of steel (See Column 3).

Art Unit: 3711

Regarding claim 9, Wieland et al. discloses the moment of inertia  $I_{xx}$  through the center of gravity of 2450 to 3200 g-cm<sup>2</sup> and moment of inertia  $I_{zz}$  of 2200 to 3000 g-cm<sup>2</sup> (See Column 6, lines 26 through 38).

Regarding claim 10, see the above regarding claims 1, 3, and 8.

Regarding claim 12, see the above regarding claim 5.

Regarding claim 14, see the above regarding claim 7.

Regarding claim 15, see the above regarding claims 1, 3, 5, 8, and 12.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajita (JP 10-005378 A) in view of Boone (USPN 5540436).

Regarding claim 1, Kajita discloses an iron club head comprising a body including a front wall having a ball-striking surface and further including a rear surface having an external rear cavity formed therein wherein the rear surface including an upper portion **6** and a lower portion **7** wherein the upper portion is separated by the external rear cavity and at least one groove **10** (See Figure 2). Kajita does not disclose having a notch in the lower portion of the rear surface. Boone discloses an iron club head having a notch **32** in the lower portion of the rear surface (See Abstract). The notch facilitates the shifting of the center of gravity relative to the heel and toe of the

Art Unit: 3711

club head (See Column 4, last paragraph to Column 5, line 55). One having ordinary skill in the art would have found it obvious to have the lower portion of the rear surface with a notch communicating with in the external cavity, as taught by Boone, in order to adjust the center of gravity of the club head.

Regarding claim 2, Kajita shows the at least one groove extending from the external rear cavity toward the heel end of the club head (See Figure 2).

Regarding claim 3, Kajita shows the at least one groove including a first groove extending from the external rear cavity toward a heel end of the club head and a second groove extending from the external cavity toward a toe end of the club head (See Figure 2).

Regarding claim 4, Kajita discloses the groove having a width of 1-10mm (0.04 to 0.39 inches) (See Paragraph 0008).

Regarding claims 5 and 6, Kajita does not disclose the lower portion extending more rearward than the upper portion of the rear surface. Boone discloses the lower surface of the rear surface extending more rearward than the upper portion of the rear surface (See Paragraph bridging Columns 3 and 4). One having ordinary skill in the art would have found it obvious to have lower portion extend more rearward than the upper portion, as taught by Boone, in order to increase the cavity volume.

Claims 8, 10-13, and 15-17 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Kajita (JP 10-005378 A) in view of Boone (USPN 5540436) further in view of OFFICIAL NOTICE.



Regarding claim 8, Kajita in view of Boone notes that the club head body is metal but does not disclose the material of the club head body. OFFICIAL NOTICE is taken that it is common within the art for club head bodies to be made of steel and/or titanium material. One having ordinary skill in the art would have found it obvious to fabricate the club head body of steel and/or titanium, as taught by the OFFICIAL NOTICE, because the material commonly and easily accessible to the application of the golf club head.

Regarding claims 10, Kajita discloses an iron club head comprising a body including a front wall having a ball-striking surface and further including a rear surface having an external rear cavity formed therein wherein the rear surface including an upper portion and a lower portion wherein the upper portion is separated by the external rear cavity and at least one groove (See Figure 2). Kajita shows the at least one groove including a first groove extending from the external rear cavity toward a heel end of the club head and a second groove extending from the external cavity toward a toe end of the club head (See Figure 2). Kajita does not disclose having a notch in the lower portion of the rear surface. Boone discloses an iron club head having a notch in the lower portion of the rear surface (See Abstract). The notch facilitates the shifting of the center of gravity relative to the heel and toe of the club head (See Column 4, last paragraph to Column 5, line 55). One having ordinary skill in the art would have found it obvious to have the lower portion of the rear surface with a notch communicating with in the external cavity, as taught by Boone, in order to adjust the center of gravity of the club head. Kajita in view of Boone notes that the club head body is metal but does not



Art Unit: 3711

disclose the material of the club head body. OFFICIAL NOTICE is taken that it is common within the art for club head bodies to be made of steel and/or titanium material. One having ordinary skill in the art would have found it obvious to fabricate the club head body of steel and/or titanium, as taught by the OFFICIAL NOTICE, because the material commonly and easily accessible to the application of the golf club head.

Regarding claim 11, see the above regarding claim 4.

Regarding claim 12, see the above regarding claim 5.

Regarding claim 13, see the above regarding claim 6.

Regarding claim 15, see the above regarding claims 10 and 12.

Regarding claims 16, see the above regarding claim 4.

Regarding claim 17, see the above regarding claim 6.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is (571) 272-4411. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim, can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Art Unit: 3711

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alvin A. Hunter, Jr.



EUGENE KIM  
PRIMARY EXAMINER